

REMARKS/ARGUMENTS

The Applicants' representative has carefully reviewed the Examiner's Office Action of March 25, 2005, in which the Examiner rejected claims 1-7, 10-15, 19, 20, 22, 23, 27, and 30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over USPN 6,851,820 and rejected claims 1-13 and 15-30 under 35 U.S.C. 103(a) as being obvious over some combination of Shoji (USPN 5,378,553), Grisamore (USPN 6,132,055), Petzl (USPN 6,499,859), and Sutherland (USPN 5,641,220).

In response to the Examiner's double-patenting rejection, the Applicants file herewith a *terminal disclaimer*. It is the applicants understanding that claim 14 is now in condition for allowance, and respectfully request notice of the same.

With respect to the Examiners rejections under 35 U.S.C. § 103(a), the Applicants respectfully traverse the Examiner's rejections below:

Rejection of independent claim 1:

The Examiner rejected independent claim 1 as being unpatentable over Shoji in view of Grisamore. It is the Examiner's position that Shoji discloses the claimed invention, except for the housing has a first connector to secure the housing to the barbecue grill. The Examiner concludes that the claims are obvious on the basis that Grisamore teaches a barbecue light where the handle itself is a light-containing tube that provides lighting for the barbecue grill, which provides motivation to use the light of Shoji on a barbecue grill. The Applicants respectfully disagree with the Examiner because (1) Shoji is not analogous art; (2) the Examiner failed to

present a *prima facie* case of obviousness and (3) evidence indicates that others have failed to make the combination suggested by the Examiner.

First, it is the Applicants' belief that the bicycle art cited by the Examiner is not analogous art and, thus, cannot be relied upon to reject the Applicants' claims. In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. The Applicants refer the Examiner to *In re Leonard M. Greene*, 1994 U.S. App. LEXIS 5103 (Fed. Cir. 1994) (non-published opinion), in which the Federal Circuit overruled an appeals board finding of obviousness. The appeals board found that a patent claim for a breakaway aircraft vane was obvious in view of Dupuy which disclosed a breakaway blade for a pugging mill or mixer. The Federal Circuit disagreed with the appeals board and held that problems of broken blades in a pugging mill are not reasonably pertinent to problems of broken air vanes on aircraft. Likewise, the applicants respectfully assert that the problems of headlamps on bicycles are not reasonably pertinent to problems of light fixtures for grills.

The prior art relied upon by the Examiner, Shoji, relates to a significantly different application than the claimed invention and, therefore, is not analogous prior art. The device disclosed in Shoji relates "specifically, to an attaching unit of a battery case used for a head lamp and the like for a component for bicycles and motorcycles," Shoji, col. 1, ll. 8-11, whereas the claimed invention relates to a removable lighting apparatus that is intended for use with barbecue grills. As such, the problems associated with Shoji are significantly different than the problems

associated with the present inventions. For example, the main problem addressed in Shoji is slipping of a battery case caused by vibration, Shoji, col. 1, l. 64 to col. 2, l. 2, whereas the problems addressed by the claimed inventions may include developing a simple and inexpensive lighting apparatus that is not hazardous to the grill user, is not located in an unobtrusive location, and does not reduce the surface area of the cooking grill.

Second, it is the Applicants belief that the Examiner has failed to present a *prima facie* case of obviousness; specifically, the Applicants assert that there is no motivation to combine Shoji and Grisamore. Even if the Examiner is correct that Grisamore identifies a need to illuminate the cooking surface of the barbecue grill, it is the Applicants belief that there still is no motivation to modify the bike headlamp of Shoji to illuminate the cooking surface of a grill. There is nothing in Shoji that suggests using the light in connection with a cooking device. Shoji doesn't even suggest using the light as anything other than a bicycle headlamp. Along the same lines, nothing in Grisamore suggests using the light in a handle for a bicycle. In fact, the Applicant believes that Grisamore teaches that one would not be successful in modifying a light fixture of a type similar to the bike lamp of Shoji. Referring specifically to col. 1, ll. 10-20, Grisamore explains that prior art, clamp-on light fixtures for barbecue grills that are designed to attach to nearby trays or other physical objects are cumbersome, awkward, and expensive and cast shadows on the cooking surface so as to obscure the desired view of food items being cooked. For this reason, the Applicant respectfully asserts that the Examiner has improperly used hindsight (i.e., the Applicants' invention) to obtain the combination.

Third, it is the Applicants belief that evidence of failure of others negatives the Examiner's obviousness rejection. The Applicants understand that handlebar mounted bike lamps have been in existence at least as early as the priority date of Shoji, March 13, 1992, given that Shoji is an improvement patent. Assuming that the Examiner is correct that Shoji discloses the claimed invention except for the light fixture being secured to a barbecue grill¹, approximately ten (10) years lapsed between date of invention of Shoji and the date of invention of the claimed invention. As discussed in Grisamore, others have attempted and failed to develop a light fixture for a barbecue a grill which is not cumbersome, awkward and/or expensive. Grisamore, col. 1, ll. 10-20; see also the specification of the instant application, p. 1, l. 19 to p. 3, l. 15 (stating that the prior art grill lights are obtrusive, hazardous, complicated to operate, and reduce the surface area of the grill).

Rejection of dependent claims 2-13

The Examiner rejected the claims which depend from claim 1 (i.e. claims 2-13) as being unpatentable over Shoji in view of Grisamore as applied to claim 1 and further in view of various other art. Because each of the rejected claims depends from claim 1, each of these dependent claims necessarily includes all of the limitations of claim 1. If an independent claim is non-obvious under § 103, then it would seem that any claim depending therefrom is also non-obvious. Therefore, the Applicants respectfully disagree with the Examiner's rejection and refer the Examiner to their response regarding claim 1 above. The Applicants also respectfully disagree with the Examiner's rejection of claims 3-5 for additional reasons, as discussed below.

¹ Note that the Applicants do not admit that Shoji discloses the remaining limitations of

The Examiner rejected claims 3-5 as being unpatentable over Shoji in view of Grisamore as applied to claim 1 above and further in view of Sutherland. The Examiner asserts that Shoji in view of Grisamore discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device. It is the Examiner's position that Sutherland teaches (1) multiple or two lighting device that is in connection with the first light device, (2) a first pod having a first internal power source and a first switch and a second pod has a second internal power source and a second switch, and (3) a handle portion between the first pod and the second pod. The Applicant respectfully disagree with the Examiner for two reasons:

First, it is the Applicants' belief that Sutherland is not analogous art and, thus, cannot be relied upon to reject the Applicants' claims. Sutherland (like Shoji, as discussed above), relates to a significantly different application than the claimed invention and, therefore, is not analogous prior art. The device disclosed in Sutherland is "particularly designed for use with bicycles," (see Sutherland, Abstract); whereas the claimed invention relates to a removable lighting apparatus that is intended for use with barbecue grills. It is the Applicants' belief that one of ordinary skill in the art would not look to bicycle art in an attempt to develop a light for a barbecue grill because the problems associated with the bicycle art are significantly different than the problems associated with the grill art.

Second, the claimed invention is substantially different than the light fixture disclosed in Sutherland. Claim 3 calls for the fixture to have a plurality of first mating members for engaging with corresponding mating members of the pods, whereas Sutherland calls for a plurality of

fixtures, one for each headlamp. As such, the claimed invention comprises fewer parts than the light fixture of the prior art. As is well known by a person of ordinary skill in the art, a device which is comprised of fewer parts is generally less expensive to manufacture and simpler to install. Claim 4 calls for the first pod to have a first power source and a first switch and for the second pod to have a second power source and a second switch, whereas Sutherland calls for the first and second pods to share a power source (i.e. the battery pack 110). Sutherland, col. 8, ll. 16-38. Because the dual headlamps of Sutherland share a power source, the two headlamps cannot be used independently of one another. Conversely, the light pods of the claimed invention have independent power sources allowing each to be used concurrently at different locations. Claim 5 calls for the fixture to have a handle portion between the first pod and the second pod, whereas the fixture of Sutherland does not have a handle portion. As discussed above, Sutherland discloses two fixtures, each having one headlamp. Conversely, the claimed invention calls for one fixture which engages with two light pods. The fixture of the claimed invention itself incorporates a handle portion between the two pods. The fixture of Sutherland does not incorporate such a handle portion.

Rejection of independent claims 15 and 27

The Examiner rejected independent claims 15 and 27 as being unpatentable over Shoji in view of Petzl and Sutherland. The Applicants respectfully disagree with the Examiner on the basis that neither Shoji nor Petzl nor Sutherland disclose a modular light. Nevertheless, the Applicants have amended claims 15 and 27 to clarify that the first mating member(s) of the housing and the second mating member of the pod(s) are modular. The amended claims are

supported by the originally filed specification on page 21: “[a]ny pod 166 that has a second mating member 180 may be attached to any light housing or fixture 128 that has a first mating member 178.” For example, the second mating member(s) of claims 15 and 27 are characterized by a standard attachment configuration such that it can be used on a plurality of light fixtures and housings, including those disclosed in Figures 14a through 19b.

Rejection of dependent claims 16-26 and 28-30

The Examiner rejected the claims which depend from claims 15 and 27 (i.e. claims 16-26 and 28-30) as being unpatentable over Shoji in view of Petzl as applied to claim 15 or over Shoji in view of Petzl and Sutherland as applied to claim 27 and further in view of various other art. Because each of the rejected claims depends from either claim 15 or 27, each of these dependent claims necessarily includes all of the limitations of either claim 15 or 27. If an independent claim is non-obvious under § 103, then it would seem that any claim depending therefrom is also non-obvious. Therefore, the Applicants respectfully disagree with the Examiner’s rejection and refer the Examiner to their response regarding claims 15 and 27 above. The Applicants also respectfully disagree with the Examiner’s rejection of various dependent claims for additional reasons, as discussed below.

The Examiner rejected claims 19 and 20 as being unpatentable over Shoji in view of Petzl and further in view of Sutherland. The Applicant respectfully disagrees with the Examiner because it is the Applicants’ belief that Sutherland does not disclose a handle portion between the first pod and the second pod. Claim 20 calls for the housing to have a handle portion between the first pod and the second pod, whereas the fixtures of Sutherland do not have a

handle portion. As discussed above, Sutherland discloses two fixtures, each having one headlamp. Conversely, the claimed invention calls for one housing which engages with two light pods. The housing of the claimed invention itself incorporates a handle portion between the two pods. The fixture of Sutherland does not incorporate such a handle portion.

The Examiner rejected claims 23, 26, and 30 as being unpatentable over some combination of Shoji, Petzl, Sutherland, and Grisamore. The Applicants respectfully disagree with the Examiner for three reasons: (1) it is the Applicants' belief that the bicycle art cited by the Examiner is not analogous art and, thus, cannot be relied upon to reject the Applicants' claims; (2) it is the Applicants' belief that there is no motivation to combine Shoji with Grisamore, because Grisamore teaches away from the invention; and (3) it is the Applicants' belief that evidence of failure of others negatives the Examiner's obviousness rejection. Please refer the Applicants' response regarding claim 1 above.

New claims 31-44

Please note that the Applicants have filed herewith new claims numbered 31-44. All of these claims call for a light mounted to the lid of a barbecue grill, the light having a timer switch. These claims do not include new matter and are fully supported by the specification. Specifically, the Applicants refer the Examiner to page 14, line 31 through page 15, line 2; page 21, lines 10 through 24; and figures 16-19b. Please note that new claims 31-36 are based upon claim 16 from issued U.S. Patent 6,851,820, which is related to this application, and include additional limitations.